

Appl. No. 10/566,332
Amdt. Dated
Reply to Final Office Action of August 17, 2010

Attorney Docket No. 374611-000162
Customer No. 73230

REMARKS/ARGUMENTS:

Claims 19 and 22 are amended. Claims 17-24 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

INTERVIEW SUMMARY:

On December 10, 2010, Patent Agent Barry Shuman conducted a telephone interview with Examiner Karl E. Group. During the interview the parties discussed the Advisory Action dated November 26, 2010. Specifically, an amendment to claim 19 that would clarify that AE was a non zero amount was discussed. Examiner Group indicated that such an amendment could be entered without an RCE.

Applicant would like to thank Examiner Karl E. Group for the courtesy of granting a telephone interview with Patent Agent Barry Shuman.

INFORMATION DISCLOSURE STATEMENT:

The Office at p. 2, paragraph 2 of the Final Office Action of August 17, 2010 states,

"A complete translation of the Japanese office action was not provided and the translation provided was not sufficiently descriptive of the Japanese document 63-210068 or the office action. The translation of the Japanese office action provided recites the reference corresponds to yttria. The title of the document 63210068 provided is states the document is directed to a carbide body which is not analogous to the claimed yttria body. Furthermore a translation or explanation of at least the abstract of JP 63-210068 was not provided."

In response, Applicant submits below a more complete English translation of the Japanese Office Action dated May 25, 2010 than that which was submitted on July 20, 2010.

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Attorney Docket No. 374611-000162
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Dispatch No.: 353193
Dispatch Date: May 25, 2010

Notification of Reasons for Refusal

Patent Application No.: Japanese Patent application 2005-511991

Drafting Date: May 18, 2010
Examiner of JPO: Takeshi OGAWA 9270 4T00
Agent Mitsuo TANAKA et al.
Applied Articles Sections 29(2) and 36

(omitted)

Reason 1: Claims 1 to 14: References 1-6

Remark: Reference 1 discloses an invention of a sintered material having yttria as a main component (see, claims, paragraph 0018, No.26 of table 2). Reference 1 fails to disclose a difference in crystal grain size between the surface and the inside region of the sintered material.

Consideration is given to this difference. It was well known to improve an intensity by reducing a variation of crystal grain size. (Please refer to page 2, upper right column, lines 1 to 5 of reference 2). Therefore, the difference from Reference 1 is only a matter of design.

(omitted)

References Cited:

- Ref. 1: JP Laid-open Patent Application Publication No. 2001-181042
- Ref. 2: JP Laid-open Patent Application Publication No. 63-210068
- Ref. 3: JP Laid-open Patent Application Publication No. 2003-086475
- Ref. 4: JP Laid-open Patent Application Publication No. 2002-362966
- Ref. 5: JP Laid-open Patent Application Publication No. 2002-255647
- Ref. 6: JP Laid-open Patent Application Publication No. 2001-335367

(omitted)

The Office at p. 2 of the Advisory Action of November 26, 2010 states,

"The translation portion of the Notification of Reasons for Refusal does not describe Japanese document 63-210068 (which was the document that was crossed off the PTO 1449) but describes Ref. 1 which is Japanese document 2001-181042. Furthermore, Japanese document 63-210068 is drawn to a carbide body not a yttria body as so described. Either applicants have the wrong description or the Japanese document is incorrect. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a)."

Applicant respectfully disagrees. The Notification of Reasons for Refusal states,

"Consideration is given to this difference. It was well known to improve an intensity by reducing a variation of crystal grain size. (Please refer to page 2, upper right column, lines 1 to 5 of reference 2)."

Reference 2 is Japanese document 63-210068. Therefore, Japanese document 63-210068 is described in the Notification of Reasons for Refusal. Applicant agrees that the subject matter of JP 63-210068 is a carbide sintered body and not Y₂O₃. However, the Japanese Office Action cites JP 63-210068 (Reference 2) as a supplement to Reference 1 (Japanese document 2001-181042). Reference 1 discloses a Y₂O₃ sintered material. The Japanese Patent Office found that Reference 1 discloses an invention of a sintered material having yttria as a main component, but correctly recognized that Reference 1 fails to disclose a difference in crystal grain size between the surface and the inside region of the sintered material. Therefore, to supplement this missing feature, the JPO cites JP 63-210068 (Reference 2) to demonstrate that it was well known to improve an intensity by reducing a variation of crystal grain size.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112:

Claims 19 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 requires AE (group II compound) however claim 19 because of the Markush terminology the AE element is optional. A dependent claim must further limit the scope from which it depends. Because AE is not required in claim 19, the claims is considered broader than the claim from which it depends.

In response, Applicant amended claim 19 to clarify that AE is not optional. In addition, Applicant further clarified that AE is a non zero amount. Withdrawal of this rejection is thus respectfully requested.

CLAIM SUGGESTION:

It is suggested to change claim 22 to "The corrosion resistant member according to claim 17 having a carbon content..." In response, Applicant amended claim 22 in the manner suggested by the Office.

ALLOWABLE SUBJECT MATTER:

Claims 17, 18, and 21-24 are allowed.

Applicant believes the foregoing amendments comply with requirements of form and thus may be admitted under 37 C.F.R. § 1.116(b). Alternatively, if these amendments are deemed to touch the merits, admission is requested under 37 C.F.R. § 1.116(c). In this connection, these amendments were not earlier presented because they are in response to the matters pointed out for the first time in the Final Office Action.

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Lastly, admission is requested under 37 C.F.R. § 1.116(b) as presenting rejected claims in better form for consideration on appeal.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

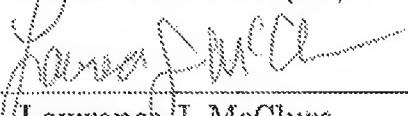
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (310) 595-3107 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 07-1896.

Respectfully submitted,

DLA PIPER LLP (US)

Date: December 16, 2010

By: 

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